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EXAMINER

ZANELLI, MICHAEL J

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Please find below and/or attached an Office communication concerning this application or proceeding.

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* MASAHIKO NAKANO
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11 Appeal 2007-1999
12 Application 10/619,034
13 Technology Center 3600
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16 Decided: March 5, 2008
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19 Before WILLIAM F. PATE, III, ANTON W. FETTING, and DAVID B.
20 WALKER, *Administrative Patent Judges*.
21 FETTING, *Administrative Patent Judge*.

22 DECISION ON APPEAL
23
24
25

26 STATEMENT OF CASE

27 Masahiko Nakano (Appellant) seeks review under 35 U.S.C. § 134 of a Final
28 rejection of claims 1-14, the only claims pending in the application on appeal.

29 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

30
31 We AFFIRM.

1 The Appellant invented a navigation apparatus using real image data
2corresponding to an image of a satellite photograph or an aerial photograph of the
3earth's surface (Specification 1:10-13). It displays information required to reach a
4destination including at least a part of a route to the destination with each of main
5points on the route as a mark on the display screen. When a user selects one of the
6main points it displays a real image showing a surrounding of the selected main
7point on the display screen on the basis of position information of the selected
8main point and real image data corresponding to position coordinates
9(Specification 2:23 – 3:12).

10 An understanding of the invention can be derived from a reading of exemplary
11claim 1, which is reproduced below (bracketed matter and some paragraphing
12added).

13 1. A navigation apparatus for displaying information required to reach
14 a destination on a display screen to guide a vehicle to the destination,
15 the navigation apparatus comprising:

16 [1] a first display control unit

17 [a] for displaying at least a part of a route to the destination on
18 the display screen and

19 [b] displaying each of main points on the route as a mark on the
20 display screen; and

21 [2] a second display control unit

22 [a] for determining whether or not a user selects one of the
23 main points and

24 [b] displaying a real image showing a surrounding of a selected
25 main point on the display screen

26 [c] on a basis of

27 position information of the selected main point and

28 real image data corresponding to position coordinates,

1 [d] when the second display control unit determines that the
2 user selects one of the main points,
3 [e] wherein the real image includes at least one of an aerial
4 photograph and a satellite photograph.
5

6 This appeal arises from the Examiner's Final Rejection, mailed March 23,
72005. The Appellant filed an Appeal Brief in support of the appeal on November
88, 2005. An Examiner's Answer to the Appeal Brief was mailed on December 22,
92005. A Reply Brief was filed on February 1, 2006. A corrected Examiner's
10Answer was mailed on June 6, 2006. Generic references to the Examiner's
11Answer in this opinion refer to the corrected June 6, 2006 Answer.

12 PRIOR ART

13 The Examiner relies upon the following prior art:

Shimizu	US 5,396,431	Mar. 7, 1995
Berstis	US 6,182,010	Jan. 30, 2001
Ihara	US 2002/0177944 A1	Nov. 28, 2002

14 REJECTIONS

15 Claims 1-3 and 7-14 stand rejected under 35 U.S.C. § 103(a) as unpatentable
16over Ihara and Shimizu.

17 Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Ihara,
18Shimizu, and Berstis.

1 ISSUES

2 The issues pertinent to this appeal are

- 3 • Whether the Appellants have sustained their burden of showing that the
4 Examiner erred in rejecting claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as
5 unpatentable over Ihara and Shimizu.
- 6 • Whether the Appellants have sustained their burden of showing that the
7 Examiner erred in rejecting claims 4-6 under 35 U.S.C. § 103(a) as
8 unpatentable over Ihara, Shimizu, and Berstis.

9 The pertinent issues turn on whether one of ordinary skill would have
10 considered that an aerial photograph of part of a travel route surrounding a
11 particular point to be an element of information that was presented to a user who
12 selected that specific point on a map of a travel route for more information.

13 FACTS PERTINENT TO THE ISSUES

14 The following enumerated Findings of Fact (FF) are believed to be supported
15 by a preponderance of the evidence.

16 *Ihara*

- 17 1. Ihara is directed towards a navigation device in which the creation of
18 object marks, setting of the destination, and so forth can be performed by
19 intuitive operations (Ihara 1:¶ 0015).
- 20 2. When a button object and desired coordinates on a map are specified in
21 Ihara, a mark is created and displayed on the map at a position
22 corresponding to the specified coordinates. In other words, button
23 objects having specific processing are displayed on a map. Then, when a

1 button object and desired coordinates on the map are specified on the
2 touch panel, a mark is displayed on the map at a position corresponding
3 to the specified coordinates. In general, the mark is a visually
4 recognizable object that indicates, for example, a favorite place, a
5 destination, or an intermediate point along the route (Ihara 1-2:¶ 0016).

6 3. In Ihara, when a button object and coordinates corresponding to a mark
7 displayed on the map are specified, it is also possible to output mark-
8 related information. If the place where the mark is attached is, for
9 example, any type of establishment or store, the mark-related
10 information is guide information such as the hours of business, the days
11 on which the store is closed, the address, the telephone number, a
12 *photograph* (image) of that place, and so forth (Ihara 2:¶ 0017).

13 4. Ihara describes the context in which its navigation device is used as one
14 in which its position and moving speed is obtained in real time by using
15 GPS (Global Positioning System) satellite systems installed in moving
16 objects, such as automobiles. In these navigation devices, a map is
17 displayed on a monitor on the basis of digitized map data. In particular,
18 navigation devices installed in moving objects are provided with a route
19 guidance function based on a route that has been set by the user. When
20 the user sets the route, he or she designates a departure point, a
21 destination point, and an intermediate point along the route (Ihara 1:¶'s
22 0004-05).

23 5. Ihara's device includes a GPS positioning unit for performing position
24 measurement on the basis of the signals obtained from the GPS antenna,
25 a vehicle speed sensor for detecting the speed of the vehicle in which the

1 navigation device is installed, a gyro sensor for detecting the rotational
2 position of the vehicle, and a position correction unit for correcting the
3 positioning result from the GPS positioning unit on the basis of output
4 values obtained from the vehicle speed sensor and the gyro sensor (Ihara
5 3:¶ 0045).

- 6 6. Ihara's device includes a display control unit; a map-matching control
7 unit for performing processing in which the vehicle position measured is
8 matched with a route on the map displayed on the display unit; and a
9 route setting control unit for calculating a recommended route based on a
10 departure point and a destination set by the user (Ihara 3:¶ 0046).

11 *Shimizu*

- 12 7. Shimizu is directed toward a navigation system by which conditions
13 around a current position can be easily recognized (Shimizu 1:56-58).
- 14 8. Shimizu's navigation system is provided with: a position measuring
15 device for measuring a current position of a movable body to which the
16 navigation system is equipped; a storing device for storing aerial
17 photograph data; a displaying device; and a display controlling device
18 coupled to the position measuring device, the storing device, and the
19 displaying device, for making the displaying device display a mark
20 indicating the measured current position on an aerial photograph image
21 on the basis of the measured current position and the stored aerial
22 photograph data (Shimizu 1:59 – 2:2).
- 23 9. In operation, conditions around the current position of Shimizu's
24 movable body, such as a group of buildings, agriculture fields, orchard
25 fields, are displayed in the aerial photograph image, with the mark

1 indicating the current position, on the display device. Thus, just by
2 comparing such conditions shown in the aerial photograph image with
3 the actual conditions in sight, one can easily recognize current conditions
4 and position (Shimizu 2:3-12).

5 PRINCIPLES OF LAW

6Claim Construction

7 During examination of a patent application, pending claims are given
8 their broadest reasonable construction consistent with the specification. *In*
9 *re Prater* , 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci.*
10 *Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004).

11 Limitations appearing in the specification but not recited in the claim are not
12 read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed.
13 Cir. 2003) (claims must be interpreted “in view of the specification” without
14 importing limitations from the specification into the claims unnecessarily)

15 Although a patent applicant is entitled to be his or her own lexicographer of
16 patent claim terms, in *ex parte* prosecution it must be within limits. *In re Corr*,
17 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing such
18 definitions in the Specification with sufficient clarity to provide a person of
19 ordinary skill in the art with clear and precise notice of the meaning that is to be
20 construed. *See also In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994) (although
21 an inventor is free to define the specific terms used to describe the invention, this
22 must be done with reasonable clarity, deliberateness, and precision; where an
23 inventor chooses to give terms uncommon meanings, the inventor must set out any
24 uncommon definition in some manner within the patent disclosure so as to give
25 one of ordinary skill in the art notice of the change).

1

2*Obviousness*

3

4 A claimed invention is unpatentable if the differences between it and the
5prior art are “such that the subject matter as a whole would have been obvious at
6the time the invention was made to a person having ordinary skill in the art.”
735 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct. 1727 (2007);
8*Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

9 In *Graham*, the Court held that that the obviousness analysis is bottomed on
10several basic factual inquiries: “[(1)] the scope and content of the prior art are to be
11determined; [(2)] differences between the prior art and the claims at issue are to be
12ascertained; and [(3)] the level of ordinary skill in the pertinent art resolved.”
13383 U.S. at 17. *See also KSR Int’l v. Teleflex Inc.*, 127 S.Ct. at 1734. “The
14combination of familiar elements according to known methods is likely to be
15obvious when it does no more than yield predictable results.” *KSR*, at 1739.

16 “When a work is available in one field of endeavor, design incentives and
17other market forces can prompt variations of it, either in the same field or in a
18different one. If a person of ordinary skill in the art can implement a predictable
19variation, § 103 likely bars its patentability.” *Id.* at 1740, 82 USPQ2d at 1396.

20 “For the same reason, if a technique has been used to improve one device,
21and a person of ordinary skill in the art would recognize that it would improve
22similar devices in the same way, using the technique is obvious unless its actual
23application is beyond his or her skill.” *Id.*

1 “Under the correct analysis, any need or problem known in the field of
2endeavor at the time of invention and addressed by the patent can provide a reason
3for combining the elements in the manner claimed.” *Id.* at 1742.

4 ANALYSIS

5 *Claims 1-3 and 7-14 rejected under 35 U.S.C. § 103(a) as unpatentable over Ihara*
6 *and Shimizu.*

7 *Claims 1, 2, 7, 8, 10, 12, and 13*

8 The Appellant argues these claims as a group.

9 Accordingly, we select claim 1 as representative of the group.
10 37 C.F.R. § 41.37(c)(1)(vii) (2006).

11 The Examiner found that Ihara described all of claim 1’s limitations except for
12the aerial or satellite photographs. The Examiner found that using such
13photographs in computerized maps was well known to those of ordinary skill at the
14time of the invention and pointed to Shimizu as evidence of such knowledge and
15practice. The Examiner concluded that it would have been obvious to a person of
16ordinary skill in the art to have implemented Ihara’s photographs with Shimizu’s
17aerial or satellite photographs to assist in navigation (Answer 5).

18 The Appellant contends that Ihara suggests a frontal view photograph rather
19than an aerial or satellite photograph (Br. 5:Argument 1) and such a frontal view
20would not suggest including a surrounding area (Br. 5:Argument 2).

21 We find that Ihara allows users to place marks on navigation maps that can be
22triggered to output information regarding the position so marked. Where the mark
23refers to a particular business, this information may include hours of operation or a
24phone number. It may also include a photo of that place (FF). While we agree

1with the Appellant that Ihara does not explicitly state what view the photo
2provides, Ihara does characterize the information as being mark-related, and this
3characterization is made by Ihara in a navigational context.

4 Thus, the issue is whether, in view of Ihara’s description that many types of
5information could be supplied to assist in the navigation around a user specified
6mark on a navigational map, and Ihara’s explicit recitation of a photograph as
7among the types that might be supplied, it would have been predictable that one of
8ordinary skill would have provided an aerial photo as one of those types of
9information. “The combination of familiar elements according to known methods
10is likely to be obvious when it does no more than yield predictable results.” *KSR*,
11127 S. Ct. at 1739.

12 Shimizu describes the use of an aerial photo in a navigation device to better
13inform a user of surrounding conditions (FF &). The whole point of providing a
14photograph in Ihara is to give the user a realistic image of what to look for. An
15aerial photo is one embodiment of a photo that certainly provides a realistic image
16of what to look for, with simply a broader scope of coverage than a frontal view as
17conjectured by the Appellant. We find that Shimizu describes why one of ordinary
18skill would have found an aerial photo to be among the types of information
19provided by Ihara’s navigational device, *viz.* to better inform a user of surrounding
20conditions.

21 The Appellant also contends that combining Shimizu with Ihara would result in
22something other than claim 1. The Appellant argues that Shimizu describes
23showing conditions around the vehicle rather than a user selectable mark on the
24map and that applying Shimizu to Ihara would have substituted the aerial
25photograph for Ihara’s map rather than Ihara’s photograph (Br. 5-7:Argument 3).

1 “When a work is available in one field of endeavor, design incentives and other
2market forces can prompt variations of it, either in the same field or a different one.
3If a person of ordinary skill can implement a predictable variation, § 103 likely
4bars its patentability.” *Id.* at 1740. Just as Shimizu describes the advantages of
5using an aerial photo to inform a user of conditions surrounding the moving
6vehicle, we find that such an information technique would be instantly
7recognizable by one of ordinary skill as applicable to Ihara’s description of
8informational techniques informing a user navigating towards a position on a map.
9“A person of ordinary skill is also a person of ordinary creativity, not an
10automaton.” *Id.* at 1742.

11 The Appellant further contends that Shimizu’s aerial or satellite photograph is
12practiced within a different context than Ihara’s map (Br. 7:Argument 4).

13 We find that both Ihara and Shimizu are directed towards navigational devices
14that portray the route for a moving vehicle and provide information to guide the
15user (FF &). Therefore, we find that the context is similar in each reference.

16 The Appellant has failed to meet its burden of showing the Examiner erred in
17rejecting claim 1.

18*Claims 3, 9, 11, and 14*

19 The Appellant argues these claims as a group.

20 Accordingly, we select claim 3 as representative of the group.

21 Claim 3 is substantially similar to claim 1 but includes a limitation that the
22selection of a point for which the aerial or satellite map is displayed is “on a basis
23of a movement state of the vehicle.”

1 The Examiner found that selecting points as part of navigation was known to
2those of ordinary skill at the time of the invention (Answer 5).

3 The Appellant repeats the contention, *supra*, that Shimizu is in a different
4context than Ihara (Br. 8), and we find, as we did *supra*, that the context in each is
5similar.

6 The Appellant has not sustained its burden of showing that the Examiner erred
7in rejecting claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as unpatentable over
8Ihara and Shimizu.

9*Claims 4-6 rejected under 35 U.S.C. § 103(a) as unpatentable over Ihara, Shimizu,*
10 *and Berstis.*

11 The Appellant contended that these claims are patentable for the same reason
12as their parent claim 3 (Br. 8). These claims therefore stand or fall with claim 3.
13The Appellant has not sustained its burden of showing that the Examiner erred in
14rejecting claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over Ihara, Shimizu,
15and Berstis.

16 CONCLUSIONS OF LAW

17 The Appellant has not sustained its burden of showing that the Examiner erred
18in rejecting claims 1-14 under 35 U.S.C. § 103(a) as unpatentable over the prior
19art.

20 On this record, the Appellant is not entitled to a patent containing claims 1-14.

1 DECISION

2 To summarize, our decision is as follows:

- 3 • The rejection of claims 1-3 and 7-14 under 35 U.S.C. § 103(a) as
4 unpatentable over Ihara and Shimizu is affirmed
- 5 • The rejection of claims 4-6 under 35 U.S.C. § 103(a) as unpatentable over
6 Ihara, Shimizu, and Berstis is affirmed.

7

8 No time period for taking any subsequent action in connection with this appeal
9 may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

10 AFFIRMED

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